

### **REMARKS/ARGUMENTS**

This Amendment responds to the issues raised in the Office Action of July 16, 2010 and accompanies a Request for Continued Examination.

The claims have been amended in order to direct them to preferred aspects of the invention, reduce issues, address comments contained in the Advisory Action of September 24, 2010 and to advance examination generally. As examples, the use of solid plastic pigments as featured in new claims 7, 8 10 and 11 is described in paragraph [0014] and in Examples 1, 2 4 and 5. The sheet gloss feature of previous claim 6 has been moved to new claim 9.

Various aspects and requirements of the new and amended claims further distinguish them from the prior art and these features are highlighted in the remarks that follow.

#### **The Rewet Casting Method**

Applicants' claims have been amended and directed to a rewet casting method. As described in paragraph [0003], it was known in the art at the time of filing of the present application that the cast-coating method includes a wet casting method, a gel casting method, and a rewet casting method. The rewet casting method includes the steps of: applying a coating color on a base paper; drying the coating color; rewetting the dried coating layer; and pressing and drying the rewetted layer to a heated drum to obtain a finished product. Claim 6 was already limited to the rewet casting method, while previously Claim 4 was not so limited.

The specification states clearly advantages of employing a rewet casting method as follows:

*"After coating, ... the coating layer in the wet state can be once dried and then rewetted with a rewetting solution and mirror finished by the rewet casting method, among which the rewet casting method is advantageous in quality and operation."* ([0022])

None of the cited references, other than D1, discloses the use of the rewet casting method at all. Thus, the claimed invention is not obvious over D2 (a primary reference) in view of D3-D6 (secondary references), because a skilled person cannot arrive at the claimed invention by combining D1-D2 and D3-D6. Also, D7 (WO 03/056101) does not describe the rewet casting method at all, and thus, the claimed invention is not obvious over D7.

Please note that D1 (Okada et al.) describes a rewet casting method in Examples 5-8 and Comparative Examples 4-6.

### Surface Treatment

In addition to the above, the claims are also amended to specify that the claimed invention includes a step of smoothing the dried layer between the drying step and the rewetting step. The advantage of this technical feature is described as follows:

*"In the present invention, sheet gloss, print gloss and other properties are improved by smoothing the coating layer before it is rewetted with a rewetting solution."* ([0011])

*"the dried coated paper is preferably subjected to a surface-treatment such as smoothing to improve sheet gloss, smoothness and print gloss or the like ..."* ([0022])

On the other hand, none of the cited references describes smoothing a coated layer between the drying step and the rewetting step of the rewet casting method. Thus, the claimed invention is not obvious over D1-D2 (the primary references) in view of D3-D6 (secondary references), because a person skilled in the art could not readily have arrived at the claimed invention by combining D1-D2 and D3-D6. Also, a person skilled in the art could not readily have arrived at the claimed invention from D7 (WO 03/056101).

In this regard, the Examiner states in the Advisory Action that cast-coated papers *"...are made using the same materials and procedures."* However, none of the references describes that a cast-coated paper is obtained by the "rewet casting method" including smoothing the coating layer between the drying step and the rewetting step. Thus, the same procedures as those of the cited inventions are not employed in the claimed invention.

In the Advisory Action, the Examiner also states, *"It is suggested to applicants to ... point out unexpected results."* As is explained above, the specification states clearly the advantage of the process of the amended claims in paragraphs [0011] and [0022], which is demonstrated by the working examples of the present specification.

### Gloss of the Web After Drying and Before Rewetting

The claims as above amended define the gloss of the web after drying and before rewetting. The technical feature of a sheet gloss of 70% or more shows the extent of the smoothing step.

None of the references describes this technical feature, and thus, the claimed invention is not obvious over a combination of D1-D2 and D3-D6; and over D7.

Incorporating a Solid Plastic Pigment

None of the references discloses use of solid plastic pigment; and it is apparent therefore that the claimed invention is not obvious over a combination of D1-D2 and D3-D6; or over D7.

In this regard, applicants note that the primary reference D1 contains descriptions that would serve to dissuade a person skilled in the art from using a solid plastic pigment. Claim 1 of D1 clearly requires use of a hollow plastic pigment having a void ratio of at least 45%, and D1 clearly state in [0013] that *"Incidentally, the improvement effect over the breathability and ink drying nature which this invention considers as a request at less than 45% in voidage is not acquired, but there are a fall of print job nature and also a fall of cast operation speed."*

Simply put, D1 teaches away from the present invention which includes plastic pigment. An important consideration in determining obviousness is "teaching away" from the claimed invention by the prior art. *In re Dow Chemical Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988). A reference teaches away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. A reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994); *see also KSR*, 127 S. Ct. at 1739-40 (2007).

Withdrawal of all of the rejections is requested for the reasons explained above.

Having responded to all of the pending rejections contained in the Office Action, Applicants submit that the claims are in condition for allowance and earnestly solicit an early Notice to that effect. The Examiner is invited to contact the undersigned if any further information is required.

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 14-1140.

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Respectfully submitted,

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